

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Bennett et al.
App. No : 10/559,401
Filed : December 2, 2005
For : OLIGONUCLEOTIDE
MODULATION OF CELL ADHESION
Examiner : Unassigned
Art Unit : 1635
Conf # : 5614

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January 15, 2008

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Jerry L. Heiner, Reg. No. 53,009

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This is a petition to withdraw holding of abandonment issued in connection with the above-identified patent application. This petition is appropriately filed because Applicants' representative did not receive a Notification of Missing Requirements, which the USPTO alleges was mailed on April 28, 2006. Withdrawal of a holding of abandonment upon a proper showing of failure to receive an Office Action is permitted under M.P.E.P. § 711.03(c)(I) and is in accordance with *Delgar Inc. v. Schuyler*, 172 U.S.P.Q. 513 (D.D.C. 1971). This petition provides the showing, as set out in 1156 OG 53, that is required to establish the non-receipt of an Office Action.

FACTS

A Notice of Abandonment for the above-referenced application was mailed on November 26, 2007 and received by the Attorney of Record on November 30, 2007. The Notice stated that abandonment was due to Applicants' failure to reply to a Notification of Missing Requirements

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(Form PCT/DO/EO/905) mailed on April 28, 2006, within the statutory period allowed for response.

After receiving the Notice of Abandonment, the Attorney of Record accessed the private PAIR system in an attempt to obtain a copy of the Notification of Missing Requirements that was allegedly mailed on April 28, 2006. In the PAIR section entitled "Transaction History" a Notice of Missing Requirements was listed as being mailed on April 28, 2006 (see Exhibit A). However, after careful inspection, the Attorney of Record could find no copy of the Notification of Missing Requirements present in the PAIR section entitled "Image File Wrapper" (see Exhibit B). Inspection of the Image File Wrapper did reveal, however, that the correspondence address was first changed to the address of the Attorney of Record on July 17, 2006 (see Exhibit C), which is nearly three months after the alleged mailing date of the Notification of Missing Requirements. Prior to July 17, 2006, the assignee's previous counsel was listed as the correspondence addressee of record (see Exhibit C). Accordingly, the Declaration of Mary Katherine Merlino, an employee of the assignee's previous counsel, which attests to the facts surrounding the non-receipt of the Notification of Missing Requirements, is annexed hereto as Exhibit D.

The Declaration of Mary Katherine Merlino, shows that the Notification of Missing Requirements that was allegedly mailed on April 28, 2006 was never received by previous counsel. In particular, Item 4 of the Declaration shows that a search of the docketing records for this application revealed no receipt of a Notification of Missing Requirements. A copy of the docketing record, which indicates where the non-received Notification would have been entered had it been received, is provided as Appendix 1 of Exhibit D. As set forth in the Declaration, a Notification of Missing Requirements mailed on April 28, 2007, would have appeared on the docket record in the column entitled "List of Actions" with a "Due Date" of June 28, 2007, which corresponds to the two-month deadline for responding to such a Notification without the payment of fees for extension of time. Accordingly, the docketing records of previous counsel indicate that they received no Notice of Missing Requirements issued in connection with the above-identified patent application.

To complete the investigation of the records associated with the above-identified patent application, the Attorney of Record checked his law firm's docketing records for the above-

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identified application and found that the physical file for the application had been transferred from previous counsel to his firm on July 14, 2006. The docketing records did not indicate that any Notification of Missing Requirements had been received with the transferred file nor did they indicate that any response to such a Notification was due (see Exhibit E). To determine whether a paper copy of the Notification of Missing Requirements was present in the physical file that was transferred from previous counsel, the Attorney of Record searched the contents of the file jacket of the above-identified application but found no copy of the Notification. Other than the physical file, no documents or information related to the above-identified application was received from previous counsel by the Attorney of Record.

REQUESTED ACTION


The showings set forth in this petition and the attached Declaration of Mary Katherine Merlino meet the requirements set out in 1156 OG 53 and M.P.E.P. § 711.03(c)(I)(A). Accordingly, Applicants respectfully request withdrawal of the holding of abandonment in the above-identified case. Upon withdrawal of the holding of abandonment, Applicants further request that prosecution of the instant application be expeditiously resumed.

Applicants believes that no fee is associated with this petition to withdraw holding of abandonment. However, if it is found that a fee is required please treat this petition as a petition to revive due to unavoidable delay under 37 C.F.R. § 1.137(a) and charge any additional fees to Deposit Account No. 11-1410. If such fee is insufficient, please treat this petition as a petition to revive due to unintentional delay under 37 C.F.R. § 1.137(b) and charge any additional fees to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 15, 2006

By: 
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